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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/774,008      | 01/31/2001  | Sang-hyun Shin       | Q62027              | 2294             |

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EXAMINER

CLARK, ISAAC R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2154

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/774,008 | <b>Applicant(s)</b><br>SHIN, SANG-HYUN |  |
|                              | <b>Examiner</b><br>Isaac R Clark     | <b>Art Unit</b><br>2154                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 January 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. <u>01/08/2002, 04/01/2003</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-12 are presented for examination

#### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The effective filing date for the subject matter defined in the pending claims in this application is 06/03/2000.

#### ***Drawings***

4. The Examiner contends that the drawings submitted on 01/31/2001 are acceptable for examination proceedings.

#### ***Claim Objections***

5. Claims 2, 3, 5, and 7 are objected to because of the following informalities:
  - a. In claim 2 lines 3-5, the phrase "by checking whether the telephone number corresponds to the second terminal" should be preceded by a verb or verb phrase relating it to the phrase "checking whether or not an IP address corresponds to the second terminal".
  - b. Claim 3 as written is conditionally dependent on claim 1 and is thus an improper independent claim. It is suggested that claim 3 be rewritten as "The method of claim wherein if the IP address is not registered, further comprising..."
  - c. Claim 5 as written is conditionally dependent on claim 1 and is thus an improper independent claim. It is suggested that claim 5 be rewritten

Art Unit: 2154

as "The method of claim wherein if the IP address is registered, further comprising..."

d. In claim 7, line 2, the final item in the list, "a name server for ..." should be preceded by the word "and".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 5, and 8-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Voit (US 6,075,783).

7. As per claim 1, Voit teaches a method of performing an Internet protocol (IP)-based communication between wireless terminals, the method comprising the steps of:

(a) receiving a request for an IP address of a second terminal from a first terminal (Col. 9 lines 8-10);

(b) upon receipt of the request, checking whether or not an IP address corresponding to the second terminal is registered (Col. 9, lines 30-34); and

(c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server (Col 13, lines 11-25).

8. As per claim 2, Voit teaches the method of claim 1 wherein the request for an IP address is made using a telephone number (Col. 9, lines 29-31), and

Art Unit: 2154

checking whether or not an IP address corresponds to the second terminal is done by checking whether the telephone number corresponds to the second terminal (Col 9, lines 31-33).

9. As per claim 5, Voit teaches the method of claim 1 further comprising the step of transmitting the IP address to one of a plurality of terminals (Col 6, lines 23-26; Col 9, lines 40-42), said plurality of terminals including said first terminal if the IP address is registered (Col 9, lines 39-43).

10. As per claim 8, Voit teaches a name server in an internet protocol (IP)-based communication system comprising:

a communication module unit for sending and receiving IP-based data (Col. 9 lines 40-43; Col. 12, lines 58-62)

a controller for registering telephone numbers and requests for translation of telephone numbers into IP addresses (Col. 9, lines 18-27); and

a database for storing IP addresses and telephone numbers as determined by the controller (Col. 9, lines 30-33).

11. As per claim 9, Voit teaches the name server of claim 8 wherein the name server further comprises a memory for storing a program for operating the controller (Col. 9, lines 17-19).

12. As per claim 10, Voit teaches the name server of claim 8 wherein the communication module unit sends and receives IP-based data to and from external devices (Col. 10, lines 20-32).

13. As per claim 11, Voit teaches the name server of claim 8 wherein the external devices include IP address servers.

Art Unit: 2154

14. As per claim 12, Voit teaches the name server of claim 8 wherein the controller receives requests for translation of telephone numbers into IP addresses from the communication module unit (Col 9, lines 30-34).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voit in view of Ray et al. (hereinafter Ray), US 6,067,529.

17. As per claim 3, Voit fails to teach the method of claim 1, further comprising the step of sending a notice requesting the second terminal to establish an IP connection if the IP address is not registered.

18. Ray teaches the method of claim 1 further comprising the step of sending a notice requesting the second terminal to establish an IP connection if the IP address is not registered (Col 3, lines 45-50, customer provides alias address which is telephone number; Col 4 lines 17-22, alias address sent by SMS to a Gatekeeper; Gatekeeper converts alias address to IP address, Col. 4 lines 25-30). It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teaching of Voit and Ray because they both deal with establishing IP sessions between a first terminal and a second terminal where the IP address of the second terminal is not known to the first terminal.

Art Unit: 2154

Furthermore, the teaching of Ray to send a notice via SMS to request the second terminal to establish an IP connection would allow the first terminal to reach the second even when the second terminal had not previously taken the step of registering an address with the name server.

19. As per claim 4, Voit in view of Ray as applied to claim 3 teaches the method of claim 3 wherein the notice requesting the second terminal to establish an IP connection using a Short Message Service (SMS) (Col 4, lines 17-22).

20. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Voit in view of 'Official Notice'.

21. Voit teaches that the method of claim 1 wherein IP address is transmitted to one or more terminals over the Internet (Col. 12, lines 45-53) but does not explicitly teach the method of claim 1 wherein the IP address is transmitted to said one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP) or user datagram protocol/internet protocol (UDP/IP). However the Examiner takes 'Official Notice' that TCP/IP is the most prevalent protocol used to interconnect hosts on the Internet. It would have been obvious to one of ordinary skill in this art at the time the invention was made to transmit the IP address to one of a plurality of terminals using transmission control protocol/internet protocol (TCP/IP), because TCP/IP provides a reliable and standard means of communicating IP addresses over the Internet.

22. Claim 7 is rejected under 35 U.S.C. 103(a) as being anticipated by Curry et al. (hereinafter Curry) US 6,359,880 in view of Martin et al. (hereinafter Martin) US 6,614,788.

Art Unit: 2154

23. As per claim 7, Curry teaches a communication system having a first terminal and a second terminal (Fig. 1), an Internet protocol (IP) address server (Col. 18, lines 51-54, "DHCP Server") name server for providing an IP address at the request of the first terminal, wherein the name server comprises:

a database 19 for storing IP addresses corresponding to telephone numbers of a plurality of terminals, said plurality of terminals including the second terminal (Col. 9, lines 44-50); and

a controller which assigns an IP address to the second terminal corresponding to information from the IP address server, if the IP address of the second terminal that is requested by the first terminal using a telephone number is not registered (Col. 18, lines 51-54).

24. Curry does not teach that the IP address obtained from the IP server is registered in the database.

25. Martin teaches the communication system of claim 7 wherein the IP address obtained from the IP server is registered in the database (Fig 11, steps 152-156; Col 2, lines 35-42; Col 3, lines 12-15, telephone number stored with IP address). It would have been obvious to one of ordinary skill in this art at the time the invention was made to combine the teachings of Curry and Martin because they both deal with the dynamic assignment of IP addresses. Furthermore, the teaching of Martin to register the phone number and IP address in a database would result in a centralized database from which network addresses could be retrieved for future communications with clients (Col. 2 lines 3-4).



Art Unit: 2154

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac R Clark whose telephone number is (703)605-1237. The examiner can normally be reached on Monday-Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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